

REMARKS

In the Office Action, the Examiner rejected claims 1-7 under 35 U.S.C. §101. Claims 1-7 were further rejected under 35 U.S.C. §112, second paragraph. Finally, claims 1 and 4-7 were rejected under 35 U.S.C. §103(a) as being unpatentable over Credit Risk Management Report in view of BusinessWeek. Claim 2 was rejected under Section 103(a) over Credit Risk Management Report in view of BusinessWeek and further in view of Elliott (2001/0042034 A1). Finally, claim 3 was rejected under Section 103(a) over Credit Risk Management Report in view of BusinessWeek and further in view of Wong et al. (USPN 6,119,933). Applicant respectfully disagrees with the above rejections and requests the reconsideration.

Regarding 35 U.S.C. §112, second paragraph

The language of claims 1-7 has been amended and clarified. As part of this amendment, claim 4 has been separated into claims 4 and 8. Therefore, Applicant requests that the rejection of the claims pursuant to Section 112, second paragraph, be withdrawn as moot.

Regarding 35 U.S.C. §103(a).

Credit Risk Management Report, in view of BusinessWeek, does not teach or suggest the invention as previously or presently claimed. Specifically, there is no objective evidence in either reference that would have led an individual to combine the relevant teachings of the references to arrive at the claimed invention. Therefore, Applicant requests that the rejection of the claims pursuant to Section 103 be withdrawn.

In rejecting claims under 35 U.S.C. §103, an Examiner bears the initial burden of presenting a *prima facie* case of obviousness. See *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by

presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him or her to make the proposed combination or other modification. See *In re Lintner*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on §103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. An Examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). The Federal Circuit has repeatedly cautioned against employing hindsight by using the Applicant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., *Grain Processing Corp. v. American Maize-Prod. Co.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, “the [E]xaminer can satisfy the burden of showing obviousness of the combination ‘only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.’” *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783

(Fed. Cir. 1992). “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). “Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact.” *Dembiczak*, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

In the present application, Credit Risk Management Report (CRMR) discusses guidelines adopted by the National Foundation for Consumer Credit (NFCC) that would require its members to disclose affiliations with lenders. CRMR also makes reference to the “members” of NFCC. However, CRMR does not mention whether those members are exempt or non-exempt entities.

Further, Applicant very respectfully submits that the teaching of BusinessWeek is directly opposite that of the claimed invention. By way of example, Applicant notes that the Examiner underlined and otherwise referenced the following passage BusinessWeek:

The agencies, which mostly operate as nonprofits, often pay their executives lavish salaries and make cushy deals for goods or services with related companies. They also steer consumers to affiliated for-profit companies that make debt consolidation or home-equity loans.

Id. at 2.

This passage, on its face, discusses non-profit credit counseling agencies referring consumers to a for-profit company. However, such methodology may be easily distinguished from the claimed invention wherein the consumer’s initial contact may be with a for-profit non-exempt entity, rather than with an exempt nonprofit. Indeed, under the present statutory scheme,

it is entirely possible that (in context of credit repair) the teaching of BusinessWeek would be illegal. Accordingly, it may be understood that BusinessWeek teaches away from the claimed invention.

Regarding 35 U.S.C. §101

In the Office Action, the Examiner rejected claims 1-7 by arguing that the claimed invention is not directed to a technological arts. However, in USPTO's recently issued Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (October 2005), it was concluded that "USPTO personnel should no longer rely on the technological arts test to determine whether a claimed invention is directed to statutory subject matter. There are no other recognized exceptions to eligible subject matter other than laws of nature, natural phenomena, and abstract ideas." See Exhibit A – Excerpt of Guidelines at 45. Therefore, since the instant rejection is based the now disapproved "technological arts" test, Applicant respectfully request the withdrawal of the instant rejection. Id.

More specifically, according to the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (October 2005), "United States patent law does not support the application of a 'technical aspect' or 'technological arts' requirement. Title 35 of the United States Code does not recite, explicitly or implicitly, that inventions must be within the 'technological arts' to be patentable." Id. at 41. Therefore, "while an invention must be 'new' and 'useful,' there is no statutory requirement that it fit within a category of 'technological arts.'" Id.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection pursuant to 35 U.S.C. §101.

Regarding New Claims 8 – 19

New claims 8 – 19 have been added to the application, with claims 9, 12 and 15 being the only new independent claims. New claim 8 depends from claim 7, which depends from claim 1.

Applicant submits that new claim 8 is allowable since it depends from claim 7, which depends from allowable claim 1. Claim 1 is allowable for the reasons set forth above.

Regarding the new independent claims, the three new independent claims each include the step of providing an exempt and non-exempt entity. As set forth above, CRMR makes reference to the “members” of NFCC. CRMR does not, however, mention whether those NFCC members are exempt or non-exempt entities. Applicant also reiterates that the teaching of BusinessWeek is directly opposite that of the claimed invention. On its face, BusinessWeek discusses non-profit credit counseling agencies referring consumers to a for-profit company. However, such methodology may be easily distinguished from the invention as set forth in the new independent claims wherein the consumer’s initial contact may be with a for-profit non-exempt entity, rather than with an exempt nonprofit.

Accordingly, for the reasons set forth above, new claim 8 and new independent claims 9, 12, and 15 are patentable over the prior art of record. The dependent claims of claims 9, 12 and 15 are also patentable over the prior because each claim depends from an allowable base claim.

Conclusion

In view of the above amendments and remarks, Applicant submits that the application is now in proper form for allowance. Such action is respectfully requested.

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Respectfully submitted,

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